



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
067937,384	12/03/86	UMBECK	6601

NICHOLAS J. SEAY  
QUARLES & BRADY  
FRIST WISCONSIN PLAZA  
P.O. BOX 2113  
MADISON, WI 53701-2113

EXAMINER	
FOX, D	
ART UNIT	PAPER NUMBER
184	1820

DATE MAILED:

02/23/90

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 5/5/89, 10/24/89 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), \_\_\_\_\_ days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- |  |   |
|--|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892.       | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948.                  |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449             | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474 | 6. <input checked="" type="checkbox"/> <u>PTD L-413</u>                         |

Part II SUMMARY OF ACTION

1. ☒ Claims 2-23 are pending in the application.  
Of the above, claims \_\_\_\_\_ are withdrawn from consideration.
2. ☒ Claims 1 have been cancelled.
3. ☒ Claims 2-16 and 22 are allowed.
4. ☒ Claims 17-21 and 23 are rejected.
5. ☐ Claims \_\_\_\_\_ are objected to.
6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. These drawings are ☐ acceptable;  
☐ not acceptable (see explanation).
10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner, ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved, ☐ disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.
12. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received  
☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

Serial No. 937384

-2-

Art Unit 184

The finality of the rejection in the office action mailed 3 January 1989 has been withdrawn in view of the following new ground of rejection. The amendment filed 5 May 1989 has been entered.

Claims 17-21 and 23 are rejected under 35 U.S.C. 112, first paragraph, as the disclosure is enabling only for claims limited to transformed cotton plants obtained by Agrobacterium-mediated transformation, as per pages 13-20 of the specification. See MPEP 706.03(n) and 706.03(z).


The specification only demonstrates the obtention of whole transformed cotton plants via Agrobacterium-mediated transformation. Given the lack of availability of plant regeneration techniques from cotton protoplasts, which would be required for alternate modes of transformation, undue experimentation would be required by one of ordinary skill in the art to obtain whole transformed cotton plants obtained by non-exemplified methods.

Claims 2-23 are deemed free of the prior art, in view of the amendment filed 5 May 1989 reciting hypocotyl inoculation and regeneration therefrom; as well as the arguments in the Brief regarding the lack of regeneration from transformed cotton roots, the lack of teaching of regeneration from hypocotyls, and the unpredictability inherent in antibiotic resistance-based selection methods.

Claims 2-16 and 22 are allowed.

Any inquiry concerning this communication should be directed to David Fox at telephone number 703-557-7415.

DF  
Fox-rb  
2-2-90

  
CHARLES F. WARREN  
SUPERVISORY PATENT EXAMINER  
GROUP ART UNIT-124